

REMARKS/ARGUMENTS

I. General Remarks and Disposition of the Claims.

The application has been reviewed in light of the Office Action mailed November 13, 2006. At the time of the Office Action, claims 1-38 were pending in this application. Claims 1-4, 7-18, 21-24, and 26-38 have been rejected. Claims 5, 6, 19, 20, and 25 are objected to. Claims 1, 2, 28, 29, and 32 have been amended herein.

All amendments are made in a good faith effort to advance the prosecution on the merits of this case and are supported by the specification as filed. Please consider the application in view of the following remarks. Applicants thank Examiner for his careful consideration of this application.

II. Remarks Regarding Claim Objections.

Claim 2 has been objected to because “the recitation of ‘element at disposal’ should be —element for disposal—to comply with claim 1.” (Office Action at 2). Applicants have amended claim 2 to correct this informality, and respectfully request the withdrawal of this objection.

III. Remarks Regarding Rejection of Claims Under 35 U.S.C. §102

A. Claims 1-4, 7-18, 21, 23, 24, 26, 27, and 29-38 Are Not Anticipated by *Hanes*.

Claims 1-4, 7-18, 21, 23, 24, 26, 27, and 29-38 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,062,295 issued to Hanes (hereinafter “*Hanes*”). Applicants respectfully traverse. *Hanes* does not disclose, expressly or inherently, every element recited in the subject claims as required to anticipate the claims under 35 U.S.C. §102(b). MPEP § 2131.

In particular, independent claims 1, 29, and 32, as amended, recite that the compression (or sealing) element fractures after the disposable downhole tool has been set in the wellbore. Nowhere does *Hanes* disclose or suggest such a element. Rather than disclosing that the compression (or sealing) element fractures after the disposable downhole tool has been set, *Hanes* is directed to a downhole tool comprising a compression element that fractures in order to set. (*Hanes*, 3:61-4:7). In other words, it is desirable that the fracturing event results in the compression or sealing element of the present invention being released. Once the compression or sealing element of the present invention fractures and is released, the tool is no longer useful because the segmented portions of the tool fall into the wellbore. Alternatively, in order for the tool to be useful in *Hanes*, the compression element must fracture first and set with or engage the well casing; it does not fracture for disposal. Accordingly, *Hanes* does not disclose or suggest that the compression (or sealing) element fractures after the disposable downhole tool has been set in the wellbore, and thus does not disclose or suggest each and every element of independent claims 1, 29, and 32.

Therefore, independent claims 1, 29, and 32, as amended, are not anticipated by *Hanes*. The remaining rejected claims depend either directly or indirectly on independent claims 1, 29, and 32. All these dependent claims, which include all the limitations of their corresponding independent claim, are allowable for at least the reasons cited above with respect to independent claims 1, 29, and 32. Accordingly, Applicants respectfully request withdrawal of this rejection with respect to claims 1-4, 7-18, 21, 23, 24, 26, 27, and 29-38.

B. Claim 28 Is Not Anticipated by *Hushbeck*.

Claim 28 has been rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,701,959 issued to Hushbeck *et al.* (hereinafter "*Hushbeck*"). Applicants respectfully traverse.

As to claim 28, as amended, *Hushbeck* does not disclose “wherein the sealing element fractures after the disposable downhole tool has been set.” Nowhere does *Hushbeck* disclose or suggest such a configuration. Rather than disclosing that the sealing element fractures after the disposable downhole tool has been set, *Hushbeck* is directed to the use of packer shoes 150 and retaining bands 152 to set the tool within the wellbore. (*Hushbeck*, 9:5-16). In other words, once the sealing element of the present invention fractures and is released, the tool is no longer useful because the segmented portions of the tool fall into the wellbore. Alternatively, the sealing element of *Hushbeck* is useful only in that it fractures to set the tool with the well casing; it does not fracture for disposal. Accordingly, *Hushbeck* does not disclose or suggest that the sealing element fractures after the disposable downhole tool has been set, and thus does not disclose or suggest each and every element of independent claim 28.

Therefore, independent claim 28, as amended, is not anticipated by *Hushbeck*. Accordingly, Applicants respectfully request withdrawal of this rejection with respect to claim 28.

IV. Remarks Regarding Rejection of Claims Under 35 U.S.C. § 103.

Claim 22 has been rejected under 35 U.S.C. 103(a) as being unpatentable over *Hanes* in view of *Hushbeck*. Applicants respectfully traverse.

As stated above, *Hanes* does not teach “wherein the compression element fractures after the disposable downhole tool has been set.” Thus, even if *Hushbeck* teaches the use of an adhesive bonding prior to deployment of the disposable downhole tool in the wellbore, the combination does not teach that the compression element fractures for disposal after the tool has been set. Applicants maintain the argument that the fracturing of *Hanes* and *Hushbeck* would not be obvious in connection with releasing the downhole tool. Since setting necessarily

occurs before releasing the tool, it would be senseless to fracture (and thus set) a tool upon release.

Accordingly, dependent claim 22 is patentable over *Hanes* in view of *Hushbeck* for at least the reasons stated above. Therefore, Applicants request that Examiner withdraw his rejection of this claim and allow it to issue.

V. No Waiver.

All of Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the cited references. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements, such as, for example, any statements relating to what would be obvious to a person of ordinary skill in the art. The example distinctions discussed by Applicants are sufficient to overcome the anticipation and obviousness rejections.

SUMMARY

In light of the above amendments and remarks, Applicants respectfully submit that the application is now in condition for allowance and earnestly solicit early notice of the same. Should Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, Examiner is invited to contact the attorney of record by telephone, facsimile or electronic mail, as indicated below.


Applicants believe that there are no fees due in association with the filing of this Response. However, should the Commissioner deem that any additional fees are due, including any fees for any extensions of time, Applicants respectfully request that the Commissioner accept this as a Petition therefore, and direct that any fees be debited from Baker Botts L.L.P., Deposit Account No. 02-0383, Order Number 063718.0158.

Respectfully submitted,

BAKER BOTTS L.L.P. (023640)

Date: January 24, 2007

By:


Melody Wirz
Registration No. 53,783
One Shell Plaza
910 Louisiana Street
Houston, Texas 77002-4995
Telephone: 713.229.1244
Facsimile: 713.229.2844
email: melody.wirz@bakerbotts.com

ATTORNEY FOR APPLICANT